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SEP 06 2011

OFFICE OF PETITIONS

In re Application of :
Acharya, et al. : DECISION ON PETITION
Application No. 09/975,831 :
Filed: 11 October, 2001 :
Attorney Docket No. 122118-175973 :

This is a decision on the petition filed on 29 August, 2011, pursuant to the regulations at 37 C.F.R. §1.47 and §1.48.

The petitions pursuant to 37 C.F.R. §1.47(a) and §1.48 are **DISMISSD**.

Rule 47/48 applicant is given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Pursuant to 37 C.F.R. §1.47 and §1.48," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** Any extensions of time will be governed by 37 C.F.R. §1.136(a).

This is **not** a final agency action within the meaning of 5 U.S.C. §704.

RULE 47

A grantable petition pursuant to 37 C.F.R. §1.47(a) requires: petition and fee; proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification: description, claims and drawings); an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; and a statement of the last known address of the non-signing inventor(s)—with diligence in the effort to ascertain the validity of the address set forth as the reasonably believed to be last known/current/valid address.

Petitioner does not seem to have worked through the requirements of the petition, as set forth above, in satisfaction of those requirements. (*See, generally:* MPEP §409.03, and §409.03(a)—the applicable statute (35 U.S.C. § 116).

RULE 48

A grantable petition pursuant to 37 C.F.R. §1.48 requires: a request to correct the inventorship that sets forth the desired inventorship change; a statement from each person being added as an inventor that the addition is necessitated by amendment of the claims and that the inventorship error occurred without deceptive intention on his or her part; an oath or declaration by the actual inventors as required by §1.63 or as permitted by §1.42, §1.43, or §1.47; the processing fee set forth in §1.17(i); if an assignment has been executed by any of the original named inventors, the written consent of the assignee (see 37 C.F.R. §3.73(b)). Petitioner must present in support of the petition pursuant to 37 C.F.R. §1.48 an oath or declaration in compliance with 37 C.F.R. §§1.63 and 1.64.

Petitioner must present in support of the petition pursuant to 37 C.F.R. §1.48 an oath or declaration in compliance with 37 C.F.R. §§1.63 and 1.64.

In particular, Petitioner has not as of this writing satisfied the requirement(s) of the petition as listed above and discussed below.

Petitioners always are reminded that for transmission by Email of any document to be accepted by the Office, written acknowledgment of receipt and readability of the message and all applicable attachments of required materials must be provided.

BACKGROUND

The record reflects as follows:

The application was deposited on 11 October, 2001, with, *inter alia*, a fully executed oath/declaration, and prosecuted thereafter.

Following a series of amendments and a non-final Office action on 28 February, 2011, Petitioner Dennis M. de Guzman (Reg. No. 41,702) filed on 29 August, 2011, *inter alia*, a request and fee for extension of time and petitions pursuant to 37 C.F.R. §1.47 and §1.48, an oath/declaration signed by co-inventors Gremett and Lingutla and:

- naming an inventive entity now comprised of Mr. Grement and Mr. Lingula, as well as non-signing inventors Kamal Acharya (Mr. Acharya), Vincent Tong (Mr. Tong), and Matthew Crampton (Mr. Crampton), but no longer including Ellen F. Butler (now Ellen F. Butler Patterson) (Ms. Butler/Ms. Butler-Patterson) and
- executed by Mr. Grement and Mr. Lingula for themselves and on behalf of non-signing co-inventors Mr. Acharya, Mr. Tong, and Mr. Crampton.
- A statement by Ms. Butler/Ms. Butler-Patterson that she no longer was a member of the inventive entity and concurring in her removal and that the former statement and the present removal were without deceptive intent.

Petitioner chose to flood the record with several hundred pages of documents that were attachments and did not go to the substance of successful or unsuccessful transmittal of the papers in question to the non-signing inventors—what is notable is that deliveries were made by a courier driver to the “porch” (*e.g.*, for Mr. Tong), or the “patio” (*e.g.*, for Mr. Crampton) or the “front door” (*e.g.*, for Mr. Archya)—and so leaving unclear as to the validity of the addresses used.

Thus, Petitioner may find it beneficial to step through the requirements of a grantable petition pursuant to 37 C.F.R.:

- §1.47(a) (*i.e.*, (1) petition and fee; (2) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification: description, claims and drawings); (3) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; and (4) a statement of the last known address of the non-signing inventor(s)—with diligence in the effort to ascertain the validity of the address set forth as the reasonably believed to be last known/current/valid address) and satisfy himself that he has complied with these requirements on submission of any renewed petition. (*See also*: the guidance in the Commentary at MPEP §409.03, and §409.03(a), *et seq.*)
- §1.48 (*i.e.*, (1) a request to correct the inventorship that sets forth the desired inventorship change; (2) a statement from each person being added as an inventor that the addition is necessitated by amendment of the claims and that the inventorship error occurred without deceptive intention on his or her part; (3) an oath or declaration by the actual inventors as required by §1.63 or as permitted by §1.42, §1.43, or §1.47; (4) the processing fee set forth in §1.17(i); (5) if an assignment has been executed by any of the original named inventors, the written consent of the assignee (see 37 C.F.R. §3.73(b)))

The present incompleteness of the record makes granting of the instant petition inappropriate.

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application. Thus, now if one wishes to know the progress in and/or status of an application or the accuracy of the data therein, one need only look at the file online.

Out of an abundance of caution, Petitioners always are reminded that those registered to practice *and* all others who make representations before the Office **must** inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.¹

Petitioner has failed to establish that the non-signing inventors have been presented with the full application and have refused to sign the declaration (the proof of the pertinent events **must** be made by a statement of someone with first hand knowledge of the events with support of the registered practitioner prosecuting this matter) or cannot be reached.

A copy of the entire application must be sent to the last known addresses of the non-signing inventors with a request that they sign the declaration for the patent application. A forwarding address should be requested, if the papers are returned, and other attempts to locate the inventor, e.g. through e-mail or the telephone continue to fail, then applicant will have established that the inventor cannot be reached. Alternatively, an oath or declaration for the patent application in compliance with 37 C.F.R. §§1.63 and 1.64 must be presented. The declaration must set forth the inventor's residence, citizenship and post office address. An oath or declaration in compliance with 37 C.F.R. §§1.63 and 1.64 signed by the Rule 1.47 applicant is required.²

Accordingly, the petitions pursuant to 37 C.F.R. §1.47 and §1.48 must be and hereby are **dismissed**.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITIONS
 Commissioner for Patents
 Post Office Box 1450
 Alexandria, VA 22313-1450


¹ See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office). See specifically, the regulations at 37 C.F.R. §10.18.

² See: MPEP 409.03(b).

By hand: Customer Service Window
Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By FAX: (571) 273-8300
ATTN: Office of Petitions

While telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2³) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).



/John J. Gillon, Jr./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

³ The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.